



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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§

re U.S. Patent Application

SOPKO et al.

Application Number: 09/935,843

Filed: August 24, 2001

For: METHOD AND SYSTEM FOR PROVIDING
MAINTENANCE SERVICE FOR LONG-TERM
CAPITAL EQUIPMENT OR FIXTURES BY
PROVIDING A WARRANTY

Art Unit 2161

Attorney Docket No. TREM.0001

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Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

COVER LETTER

Sir:

[x] The fee for submission of claims is calculated as shown below:

FOR	TOTAL WITH NEW CLAIMS ADDED	TOTAL CURRENTLY ON FILE	CLAIMS PAID	RATE	CALCULATION
Total Claims	16	16	-XX (Over 20)	x \$18	0
Independent Claims	3	3	-XX (Over 3)	x \$84	0
MULTIPLE DEPENDENT CLAIM(S)				+ \$280	
REDUCTION FOR FILING BY SMALL ENTITY (note 37 C.F.R. §§ 1.9, 1.27, 1.28).				x ½	0
				TOTAL	0

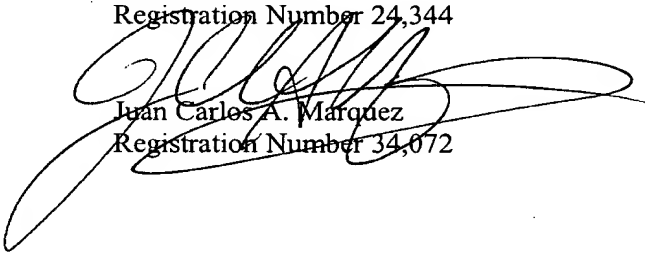
In addition, the below-identified communications are submitted in the above-captioned application or proceeding:

- | | |
|--|---|
| <input type="checkbox"/> Response to Office Action
(with Claim Amendments) | <input type="checkbox"/> Petition for Extension of Time |
| <input checked="" type="checkbox"/> Information Disclosure Statement w/refs. | <input type="checkbox"/> Terminal Disclaimer |
| <input type="checkbox"/> Preliminary Amendment | <input type="checkbox"/> Letter to Draftsperson |
| <input type="checkbox"/> Substitute Specification | <input type="checkbox"/> Claim chart |
| <input checked="" type="checkbox"/> Statements & Pre-exam Search Report
w/refs. | <input checked="" type="checkbox"/> Petition to Make Special Under 37 CFR 1.102(d)
for Accelerated Examination |

- [] Please charge my **Deposit Account Number** _____ in the amount of _____ to cover the fees for _____. A duplicate copy of this paper is enclosed.
- [x] A check in the amount of **\$130.00** to cover the petition fee is enclosed.
- [x] The Commissioner is hereby authorized to charge any additional fees associated with this communication, including patent application filing fees and processing fees under 37 C.F.R. § 1.16 and 1.17, or credit any overpayment to **Deposit Account Number 08-1480**.

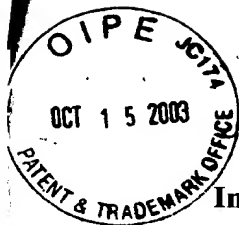
Respectfully submitted,

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October 15, 2003



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Washington, D.C. 20231

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102(d)
FOR ACCELERATION EXAMINATION

Sir:

Pursuant to 37 C.F.R. § 1.102(d), Applicants respectively request the application to be examined on the merits in conjunction with the pre-examination search results, the detailed discussion of the relevance of the results and amendments as filed concurrently.

Substantive consideration of the claims is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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STATEMENTS & PRE-EXAMINATION SEARCH REPORT
SUPPLEMENTAL TO
THE PETITION TO MAKE SPECIAL

Sir:

Pursuant to 37 C.F.R. §§ 1.102 and MPEP 708.02 VIII, Applicants hereby submit that (1) all claims of record are directed to a single invention; (2) a pre-examination search has been conducted according to the following field of search; (3) one copy of the each references deemed most closely related to the subject matter encompassed by the claims are enclosed; and (4) a detailed discussion of the references pointing out how the claimed subject matter is patentable over the references is also enclosed herewith.

FIELD OF THE SEARCH

The field of search covered Class 705, subclasses 1 and 7. Additionally, a computer database search was conducted on the USPTO systems EAST and WEST, a keyword search was also conducted in Class 700, subclasses 96, 100 and 108, and a literature search was also conducted on the Internet for relevant non-patent documents and in DIALOG using Dialog Classic in the following files: (2,3,4) Inspec, (6) National Technical Information Service, (8) Ei Compendex, (16) Gale Group Prompt, (34) Sci-Search, (35) Dissertation Abstracts, (94) Japanese Science & Technology, (99) Wilson Applied Science & Technology Abstracts, (233)

Internet & Personal Computing Abstracts, (238) Abstracts in New Technology, (434) SciSearch, (624) McGraw-Hill Co. and (636) Gale Group Newsletter. Examiner James Trammell in Class 705 (Art Unit 3621) was consulted in confirming the field of search.

The search was directed towards a method and system for providing maintenance service for long-term capital equipment or fixtures by providing a warranty. In particular, the search was directed towards a method for providing maintenance service for long-term capital equipment or fixtures by providing a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of initial maintenance service while the warranty transfers from an owner to a provider the risk of maintaining performance of the long-term capital equipment or fixtures within a reasonable range from a predetermined start-up standard. Note we limited our search to U.S. patents and publications having a filing date and foreign patents and literature having a publication date prior to August 24, 2001.

LIST OF RELEVANT REFERENCES

The search revealed the following U.S. or foreign patents and literature, copies of which are listed in numerical order for convenience:

U.S. Patent Number Inventor(s)

5,249,120	Foley
5,608,658	Yao et al. ✓
5,761,432	Bergholm et al. ✓
6,049,742	Milne et al. ✓
6,182,048	Osborn et al. ✓
6,578,001	Schramek ✓

Published Patent Application Inventor(s)

2001/0051883	Loveland ✓
2002/0035495	Spira et al. ✓
2002/0120535	Yu ✓
2002/0138289	Thielges et al. ✓
2002/0143421	Wetzer ✓
2002/0143564	Webb et al. ✓

2002/0161600	Stubiger et al. ✓
2002/0161608	Loveland ✓
2002/0184135	Zakaria ✓
2003/0004741	Johnson et al. ✓
2003/0014342	Vande Pol ✓
2003/0040934	Skidmore et al. ✓
2003/0061004	Discenzo ✓
2003/0101062	Taber, Jr. ✓

Literature Documents:

“National Clearinghouse for Educational Facilities: Roof Maintenance and Repair”, source(s): NCEF

“Technical Information Center: Literature On Products And Services For Powerplant Design, Operation, And Maintenance”, source(s): Power

“A Company 100 Years In The Making (Simon Roofing)”, source(s): Indianapolis Business Journal

“Artful Experts in Mechanical Rejuvenation Tell How and Why They Serve This Critical Niche”, source(s): Printing News

Discussion of References:

U.S. Pat. App. Pub. No. 2003/0040934 shows a system and method for collecting information from a physical home inspection, formatting the results into a report allowing secured access to the results of the inspection, and transmitting the results to a home warranty underwriting system for automated customization of home warranty insurance policies. See figures and claims. However, ‘934 provides a warranty by **home insurance underwriter** (page 3, paragraph [0018]) to a homeowner, rather than a warranty by a **maintenance service provider** (defined as “the person, party or entity responsible for the operation of the maintenance service and warranty” page 1, paragraph [1]) to an owner as recited in claim 1 of the present invention (“*warranty, includes transferring from owner to a provider the risk of maintaining performance*”). In particular, the home inspection in ‘934 was conducted by a home inspector (who is independent from the buyer, seller or any maintenance service providers) before the purchase of a house (page 1, paragraphs [0002], [0003]), rather than the afore-maintained

maintenance service provider. As such, '934 does NOT concern "*providing a warranty ... in conjunction with a purchase of an initial maintenance service,*" or "*repairing the long-term capital equipment or fixtures to reach the start-up standard*", "*developing a maintenance schedule,*" or "*maintaining*" accordingly as recited in claim 1 of the present invention. In addition, '934 only involves "home inspection items" (page 3, paragraphs [0020]) rather than any "long-term capital equipment or fixtures" (e.g. "industrial machinery and other plant systems in a facility" page 8, paragraph [33], "HVAC systems, roads, underground sewer systems, etc" page 15, paragraph [57]) as recited in claim 1 of the present invention.

U.S. Patent Application Number 2002/0143564 shows a method of home maintenance comprising tracking a household inventory of items and related maintenance tasks for a user in a calendaring system and inventory system. The method includes notifying the user with a reminder from a home maintenance web site with the reminder including a notice to perform a maintenance task on an item of the household inventory and including a network link to the home maintenance web site. A computer-based home maintenance system comprises a user interface, a home maintenance website, a maintenance notification, and a network communication link permitting communication between the user interface and the home maintenance web site. The system provides retailer(s) 36 and manufacturer(s) 38 with limited access to their databases via a web site 48 for user information requests regarding maintenance, warranties, etc (figures, claims and [0036]+). However, '564 provides a warranty by a **retailer** or **manufacturer** of a household item (page 3, paragraph [0036]) to a homeowner, rather than a warranty by a **maintenance service provider** to an owner as recited in claim 1 of the present invention. In particular, the "cleaning, maintenance, repair" in '564 was conducted by a home owner (who is independent from any maintenance service providers) before the purchase of a house (page 1, paragraph [0002]), rather than the afore-maintained maintenance service provider. As such, '564 does NOT concern "*providing a warranty ... in conjunction with a purchase of an initial maintenance service,*" or "*repairing the long-term capital equipment or fixtures to reach the start-up standard*", "*developing a maintenance schedule,*" or "*maintaining*" accordingly as recited in claim 1 of the present invention. In addition, '564 only involves "items in the home, such as appliance" (page 1, paragraph [0003]) rather than any "long-term capital equipment or fixtures" (e.g. "industrial machinery and other plant systems in a facility" page 8, paragraph [33], "HVAC systems, roads, underground sewer systems, etc" page 15, paragraph [57]) as recited in claim 1 of the present invention.

U.S. Pat. App. Pub. No. 2002/0143421 shows a method for managing maintenance of equipment, the method comprising, storing component data on components of an equipment; storing worker data on maintenance personnel associated with corresponding qualifications; associating at least one predictive maintenance factor with the corresponding component data; and scheduling maintenance for a maintenance time period for at least one of the components based on the component data, the worker data, the associated predictive maintenance factor, and an elapsed time with respect to an installation date of at least one component. However, '421 merely supports an original warranty provided by an equipment **manufacturer** (page 8, paragraph [0093]) to an equipment owner starting from the time of purchase of the **equipment**, rather than a warranty by a **maintenance service provider** to an owner starting from the time of purchase of the **initial maintenance services** as recited in claim 1 (*"a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of an initial maintenance service"*) of the present invention. In particular, the equipment manufacturer in '421 may be independent from any maintenance service providers. As such, '421 does NOT concern *"providing a warranty ... in conjunction with a purchase of an initial maintenance service,"* or *"repairing the long-term capital equipment or fixtures to reach the start-up standard"* as recited in claim 1 of the present invention. In addition, '421 only involves "equipment" (page 1, paragraphs [0002]-[0004]) but not "fixtures" (e.g. roof, "roads, underground sewer systems, etc" page 15, paragraph [57]) as recited in claim 1 of the present invention.

The following publications share the major deficiencies as U.S. Pat. App. Pub. No. 2002/0143421, i.e., they merely concerns an original warranty provided by an equipment **manufacturer** to an equipment owner starting from the time of purchase of the **equipment**, rather than a warranty by a **maintenance service provider** to an owner starting from the time of purchase of the **initial maintenance services** as recited in claim 1 (*"a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of an initial maintenance service"*) of the present invention. US Pat. App. No. 5,608,658 merely inspects a batch of units of a product before they are supplied to customers with warranties. During the inspection, the units identified as being defective are repaired. US Pat. App. Pub. No. 20020120535 discloses a website system for providing on-line data-exchange and a collaborative service for return and repair processes via a network. However, '535 merely involves original warranty provided by an equipment/component **manufacturer** (page 1, paragraph [0011]). US Pat. App. Pub. No. 20030101062 provides a variation of the ESCO business model which incorporates elements of a large scale procurement of energy efficiency resources on behalf of a number of host customers.

Where appropriate, cost and performance guarantees are incorporated into the procurement specifications (page 2, paragraph[0038]).

US Pat. App. Pub. No. 20020184135 matches buyers with sellers in order to sell used equipment. However, '135 merely involves a broker, such as an equipment dealer or manufacturer, of a transaction. '135 does not involve any maintenance services or maintenance service providers. At most, the broker provides services including vehicle inspection, reconditioning, extended warranty, etc. to allay the buyer's concerns about the condition of the equipment, but the broker does not provide the after-purchase maintenance services (page 1, paragraph [0006]). '135 merely extends an original warranty provided by an equipment **manufacturer** (page 8, paragraph [0093]) to an equipment owner starting from the time of purchase of the **equipment**, rather than a warranty by a **maintenance service provider** to an owner starting from the time of purchase of the **initial maintenance services** as recited in claim 1 of the present invention. In particular, the broker in '135 may be independent from any maintenance service providers. As such, '135 does NOT concern *"providing a warranty ... in conjunction with a purchase of an initial maintenance service,"* or *"repairing the long-term capital equipment or fixtures to reach the start-up standard"* as recited in claim 1 of the present invention. In addition, '135 only involves "equipment" (page 1, paragraphs [0002]-[0004]) but not "fixtures" (e.g. roof, "roads, underground sewer systems, etc" page 15, paragraph [57]) as recited in claim 1 of the present invention.

US Pat. App. No. 6,182,048 teaches a system and method for automated risk-based pricing of a vehicle warranty insurance policy. A processor receives the request and uses analytical tools in conjunction with an environmental database, a vehicle database, and a historical database, to generate a vehicle warranty policy. The processor generates a price, conditions and terms for the request using a risk-based pricing algorithm. However, the so-called vehicle warranty insurance policy in '048 actually provides an insurance than a product warranty such that the policy is offered by an **insurance underwriter** (page 3, paragraph [0018]) to a owner, rather than any warranty by any **maintenance service provider** to an owner as recited in claim 1 of the present invention. In particular, all costs (e.g. environmental costs, mileage-based costs in Fig. 4) are estimated from pre-existing databases (e.g. historical contracts in Fig. 4) such that no actual inspection is conducted right before the issuance of the policy in '048. On the other hand, the afore-maintained maintenance service provider "diagnoses existing conditions of the long-term capital equipment or fixtures" as recited in claim 1 of the present invention. As such, '048 does NOT concern *"providing a warranty ... in conjunction with a purchase of an*

initial maintenance service,” or “repairing the long-term capital equipment or fixtures to reach the start-up standard”, “developing a maintenance schedule,” or “maintaining” accordingly as recited in claim 1 of the present invention. In addition, ‘934 only involves “vehicles” rather than any “long-term capital equipment or fixtures” (e.g. “industrial machinery and other plant systems in a facility” page 8, paragraph [33], “HVAC systems, roads, underground sewer systems, etc” page 15, paragraph [57]) as recited in claim 1 of the present invention.

The following publications share the major deficiencies as US Pat. App. No. 6,182,048, i.e., not concerning any warranty offered by a **maintenance service provider** to an owner as recited in claim 1 of the present invention. US Pat. App. No. 6,578,001 provides a system and method of reducing allocated vehicle warranty costs from a stored historical repair database of repairs wherein the database contains information related to repair areas, repair costs, and repair descriptions. The method further includes identifying within each group of repair areas those repair descriptions having a relatively high cost within each respective group so that work to be performed on the repairs may be prioritized in accordance with the ranking in order to reduce the warranty costs.

US Pat. App. Pub. No. 20010051883 provides a computer accessible system for electronically storing a model which communicates the physical attributes of a structure along with warranty, insurance and other information relative to that structure. However, ‘833 does NOT concern “*diagnosing existing conditions of the long-term capital equipment or fixtures,”* “*providing a warranty ... in conjunction with a purchase of an initial maintenance service,”* or “*repairing the long-term capital equipment or fixtures to reach the start-up standard*”, “*developing a maintenance schedule,”* or “*maintaining*” accordingly as recited in claim 1 of the present invention. US Pat. App. Pub. No. 20020161608 is a CPA based upon the ‘883 application and shares the same deficiencies.

US Pat. App. Pub. No. 20020161600 offers technical services to customers on an outsourced basis according to a menu of services available. Technical services may be performed at manufacturing plants and other types of plants and business facilities by outside service providers (page 1, paragraph [0002]). For example, software updates are made, motors are replaced, system status analyses are carried out, etc (page 1, paragraph [0003]). A menu is provided for categories of equipment on which the technical services provider offers technical services. A guarantee may be included in the performance based contract to specify an up-time (e.g. 98%) for the on-line service (page 5, paragraph [0065]). However, the guarantee is provided

for as a key performance indicator (page 3, paragraph [0035]) for defining the performance of a serviced target right after the maintenance services is rendered rather than for a specified time period after the initial maintenance services (“*providing a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of an initial maintenance service, said providing of the warranty, includes transferring from owner to a provider the risk of maintaining performance of the long-term capital equipment or fixtures during a specified time and within a predetermined start-up standard*”) as recited in claim 1 of the present invention. In particular, no risk is transferred from the owner to the maintenance service provider since a contract is prepared for agreement between the customer and provider, and task sheets or maintenance schedules are prepared outlining the scope of the work, and estimates of costs borne by the customer only (page 5, paragraph [0060]).

US Pat. App. Pub. No. 20030014342 provides an alternative, free-market management system designed to deliver a superior product, at lower cost, with an insured guarantee, and without environmental regulatory oversight by government. The system uses an insured, certified best-practice form of process certification that objectively accounts the financial value of ecosystem resources. The conduct of practice within the system accounts the price of assets at risk and characterizes their function by which to market them for their ability to offset the environmental impacts of industrial, commercial, and residential activities. Generally, the practitioner agrees to: operate under documented, guaranteed, and validated process specifications; obtain insurance to repair, mitigate, or offset externalities; and improve best practice through education and scientific research. The certifying company agrees to: audit validation reports against conditions on the ground; carry reinsurance in case of insufficient indemnity or bankruptcy; coordinate data and supply composite data; and manage complaints and arbitrate primary settlements (page 16, paragraph [0150]). However, ‘342 does not involve any warranty or guarantee of long-term capital equipment or fixture maintenance services as now recited in claim 1 of the invention.

The following patents and the above-listed literature documents are of general interest for showing methods and systems for providing maintenance service. However, they do warranty or guarantee of long-term capital equipment or fixture maintenance services as now recited in claim 1 of the invention.

US Pat. App. Pub. No. 20020035495 provides an assessment of the maintenance and technical service needs of a plant and recommends services for outsourcing selected from a menu

of services. However, '495 does not involve any warranty or guarantee of long-term capital equipment or fixture maintenance services as now recited in claim 1 of the invention.

US Pat. App. Pub. No. 20030004741 provides vehicle service and warranty information to service technicians. In particular, '741 involves manufacturer's or dealer's warranty rather than any warranty or guarantee of long-term capital equipment or fixture maintenance services as now recited in claim 1 of the invention.

US Pat. App. Pub. No. 20020138289 provides a system and method for managing property that in one embodiment provides a network-based system and method for creating, tracking and managing events, known herein as "incidents", such as service requests, maintenance reminders and other events associated with managing property for supporting and enhancing the functions of tenant, property manager and vendor. However, '289 does not involve any warranty or guarantee of long-term capital equipment or fixture maintenance services.

US Pat. App. Pub. No. 20030061004 controls a process having one or more motorized pumps and associated motor drives, and employs machine diagnostic and/or prognostic information in connection with optimizing an overall business operation. However, '004 does not involve any warranty or guarantee of long-term capital equipment or fixture maintenance services as now recited in claim 1 of the invention.

US Pat. App. No. 5,249,120 merely provides an automated manufacturing cost estimating method and system. However, '120 does not involve any warranty or guarantee.

US Pat. App. No. 5,761,432 provides an attribute design database system for inventory management, order process management and design management. The system operates in a telecommunications management network provisioning environment. However, '432 does not involve any warranty or guarantee.

US Pat. App. No. 6,049,742 uses a computer-implemented decision-support tool serves as a solver to generate a projected supply planning (PSP) or estimated supply planning (ESP) match between existing assets and demands across multiple manufacturing facilities within the boundaries established by the manufacturing specifications and process flows and business policies to determine what supply can be provided over what time-frame by manufacturing and establishes a set of actions or guidelines for manufacturing to incorporate into their manufacturing execution system to ensure that the delivery commitments are met in a timely fashion. However, '742 does not involve any warranty or guarantee.

CONCLUSION

Based on the results of the comprehensive prior art search as discussed above, Applicants contend that the computer-implemented method (claim 1), the automated system (claim 9), or the computer program product (claim 10) for providing maintenance service for long-term capital equipment or fixtures, especially the feature of "providing a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of an initial maintenance service, said providing of the warranty, includes transferring from owner to a provider the risk of maintaining performance of the long-term capital equipment or fixtures during a specified time and within a predetermined start-up standard" is patentably distinct from the cited prior art references.

In particular, the computer-implemented method for providing maintenance service for long-term capital equipment or fixtures of the invention, comprises the steps of: diagnosing existing conditions of the long-term capital equipment or fixtures; providing a warranty on the long-term capital equipment or fixtures in conjunction with a purchase of an initial maintenance service, said providing of the warranty, includes transferring from owner to a provider the risk of maintaining performance of the long-term capital equipment or fixtures during a specified time and within a predetermined start-up standard; repairing the long-term capital equipment or fixtures to reach the start-up standard if any of the existing conditions are below the predetermined start-up standard; developing a maintenance schedule according to the predetermined start-up standard and any of existing conditions which are beyond the predetermined start-up standard; and maintaining the long-term capital equipment or fixtures according to the maintenance schedule so as to fulfill the warranty.

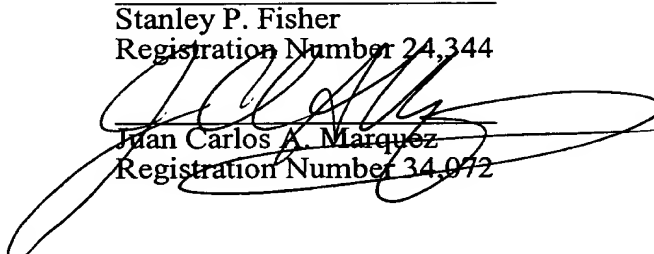
In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art references, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable consideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the

above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

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